

## REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited. In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claim 1 has been amended, and new claims 23-27 have been added. No new matter has been added. Accordingly, Applicants believe that all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

### Rejections

#### Rejection Under 35USC Section 102(e)

Claims 1-11 and 19-21 have been rejected under 35 USC Section 102(e), as being anticipated by U.S. patent 6,141,111 to Kato ("Kato"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 1 and features in the other claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under 102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

Independent claim 1 (amended), and its dependent claims 2-11 and 23-26, are

patentably distinguishable over the cited reference because claim 1 emphasizes the novel features of the present invention by which image processing operations to be performed on user-selected image files are specified both by commands and by markings on a document. In this regard, claim 1 recites a method for processing image files which includes:

“detecting a command to perform an initial processing operation on user-selected ones of the image files;

optically scanning a document to form a document image in response to the command;

analyzing the document image to detect control information on the document;

if the control information is detected, performing the initial processing operation on the user-selected ones of the image files;

analyzing the document image to detect at least one marked processing operation marked on the document;

if the at least one marked processing operation is detected, performing the at least one marked processing operation on corresponding ones of the user-selected ones of the image files.” (emphasis added)

The Kato reference describes a method and system in which the image processing operations for user-selected image files are specified only by markings on a document. For example, image processing operations such as printing images with a particular image quality 304 or in a particular image size 305 may be specified by markings made on the extra-copy designation sheet 300 (Fig. 8). However, “detecting a command to perform an initial processing operation on user-selected ones of the image files”, and then “performing the initial processing operation on the user-selected files”, as recited is Applicants’ claim 1, is absent from the Kato reference. There is no initial processing operation performed on the user-selected ones of the image files as taught by Kato.

The Office states that detecting a command to perform an initial processing operation is taught by Kato at col. 5, lines 50-61. Applicants believe, however, that the operator designating the printing of the extra-copy designation sheet 100 using the control panel 6, as taught by Kato, is completely different from “detecting a command to perform an initial processing operation on user-selected ones of the image files”, as recited in Applicants’ claim 1. Furthermore, it follows that if an initial processing operation for user-selected ones of the image files is not taught by Kato, then “performing the initial processing operation on the user-selected ones of the image files”, as recited in Applicants’ claim 1, is not possible.

Nor could the compression of the image data to form the image index portion 102 (e.g. the thumbnail images) of the printed sheet 100 of Kato teach Applicants' claimed limitations, because the compression taught by Kato is performed on all the image files, not just on the user-selected ones of the image files. It is precisely the markings made by the user on the printed sheet 100 containing thumbnails of all the images that define the user-selected ones of the image files as taught by Kato (col. 6, lines 21-34; also note location of markings made on Figs. 4A, 6, 8, etc.).

Accordingly, the rejection is improper at least for the above-stated reasons and should be withdrawn.

Dependent claim 5 is further patentably distinguishable over the cited reference because claim 5 emphasizes the novel features of the present invention in which the presence or absence of control information on the document determines how the initial processing operation is performed. In this regard, claim 5 recites a method for processing image files which includes:

“if the control information is not detected, performing the initial processing operation on the document image.” (emphasis added)

The Kato reference does not disclose what, if any, processing operations are performed when a document that is different from the extra copy designation sheet 100 is scanned.

Independent claim 19, and its dependent claims 20-21, are patentably distinguishable over the cited reference because claim 19 emphasizes the novel features of the present invention by which image processing operations to be performed on user-selected image files may be specified both by commands, and by markings on a document. In this regard, claim 19 recites a multifunction printing system which includes:

“a processor;  
an input port connected to the processor for receiving image files;  
an interface connected to the processor for receiving a command to initiate a processing sequence and for specifying an initial operation to be performed on the image files by the processor during the processing sequence; and

a scanner connected to the processor for receiving and optically scanning a combination proof and order sheet specifying a marked operation to be performed on selected ones of the image files by the processor during the processing sequence.” (emphasis added)

As explained heretofore with regard to claim 1, the Kato reference describes a method and system in which the image processing operations are specified only by markings on a document. As recited in Applicants’ claim 19, however, an image processing sequence includes both “an initial operation to be performed on the image files” and “a marked operation to be performed on selected ones of the image files”. No initial image processing operation is taught by the Kato reference. Accordingly, the rejection is improper at least for the above-stated reason and should be withdrawn.

### **Formalities**

#### **Allowable Subject Matter**

Applicants acknowledge, with appreciation, the allowance of claims 12-18 and 22.

### **Conclusion**

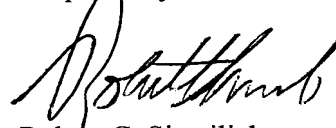
Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION  
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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12/22/04

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